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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**DECLARATION OF JOHN C. ROCKETT, Ph.D.
UNDER 37 C.F.R. § 1.132**

I, JOHN COUGHLIN ROCKETT III, Ph.D., declare and state as follows:

1. Since 1995 I have been engaged full-time in molecular toxicology research, with an emphasis on the application of expression profiling techniques, including but not limited to nucleic acid microarray expression profiling techniques, to studies of the mechanisms of toxicant action and to the design of assays to monitor toxicant exposure.

2. My curriculum vitae, including my list of publications, is attached hereto as Exhibit A.

3. For the past 5 years, my work has focused primarily on analyzing the effects of potentially hazardous environmental agents, such as heat, water disinfectant byproducts, and conazole fungicides on the male reproductive tract. Although we are interested in the basic mechanisms of action of such toxicants, we also have two practical goals in mind: first, to identify individual agents and families of agents that adversely affect male reproductive development and function, and second, to develop methods for monitoring human exposure to such agents, particularly methods capable of identifying toxicant exposure at an early stage.

4. I have relied on expression profiling as a principal approach to these goals. Expression profiling, by

reporting the expression levels of thousands of genes simultaneously, gives us an opportunity to identify and group toxicants based on similarities in the patterns of gene expression they induce in cells and tissues; the gene expression profiles induced by treatment with known testicular toxins serve as standards, molecular signatures or molecular fingerprints as it were, against which the patterns of gene expression induced by agents of unknown toxicity may be compared and judged. In addition, gene expression profiling may give us the opportunity to detect toxicity before more gross phenotypic changes become manifest.

5. In keeping with this research emphasis, I have until recently:

served on the Microarray Technical Subcommittee of the United States Environmental Protection Agency (EPA) Genomics Task Force, and

served on the Scientific Committee for the conference series on "Critical Assessment of Techniques for Microarray Data Analysis," held annually at Duke University, Durham, NC;

and I currently

serve on the Technical Committee on the Application of Genomics to Mechanism-Based Risk Assessment of the International Life Sciences Institute's Health and Environmental Sciences Institute,

serve on the Genomics and Proteomics Committee of the National Health and Environmental Effects Research Laboratory of the EPA's Office of Research and Development,

belong to the [North Carolina Research] Triangle Array Users Group,

belong to the Molecular Biology
Speciality Section of the Society of Toxicology,
and

belong to the Triangle Consortium for
Reproductive Biology.

In addition, I am the principal investigator on a cooperative research and development agreement (CRADA) entitled "Development of a Genetic Test for Male Factor Infertility." Prior to this, I was a co-principal investigator on a materials cooperative research and development agreement (MCRADA) to print oligonucleotide-based microarrays; and from 1999 - 2002, I was coinvestigator on a CRADA to develop gene microarrays for toxicology applications.

6. I presume the reader's familiarity with the basic construction and operation of microarrays. For purposes of the discussion to follow, I use the phrase "nucleic acid microarray" and, equivalently, the term "microarray" to refer generically to the various types of nucleic acid microarray that include immobilized nucleic acid probes of sufficient length to permit specific binding, with minimal cross-hybridization, to the probe's cognate transcript, whether the transcript is in the form of RNA or DNA. Although this definition excludes microarrays having shorter probes, such as the 20-mer probes of arrays manufactured by Affymetrix, Inc., many of the comments that follow nonetheless apply to such microarrays as well.

7. Although my own work with microarrays dates back only to 1998, and high density spotted nucleic acid

microarrays themselves date back perhaps only to 1995,¹ microarrays are by no means the only, nor the first, expression profiling tool. As I describe in detail in my *Xenobiotica* review,² there are a number of other differential expression analysis technologies that precede the development of microarrays, some by decades, and that have been applied to drug metabolism and toxicology research, including:

(1) differential screening; (2) subtractive hybridization, including variants such as chemical cross-linking subtraction, suppression-PCR subtractive hybridization and representational difference analysis; (3) differential display; (4) restriction endonuclease facilitated analyses, including serial analysis of gene expression (SAGE) and gene expression fingerprinting; and (5) EST analysis.

8. In my own earlier research, I used both reverse-transcriptase polymerase chain reaction (RT-PCR) and suppression-PCR subtractive hybridization (SSH) to study patterns of differential gene expression caused by hepatic challenge with nongenotoxic and genotoxic hepatotoxins.³

¹ Schena et al., "Quantitative monitoring of gene expression patterns with a complementary DNA microarray," *Science* 270:467-470 (1995), attached hereto as Exhibit B.

² Rockett et al., "Differential gene expression in drug metabolism and toxicology: practicalities, problems and potential," *Xenobiotica* 29:655-691 (1999) (hereinafter, "*Xenobiotica* review"), attached hereto as Exhibit C.

³ See, e.g., Rockett et al., "Molecular profiling of non-genotoxic carcinogenesis using differential display reverse transcription polymerase chain reaction (ddRT-PCR)," *European J. Drug Metabolism & Pharmacokinetics* 22(4):329-33 (1997), and Rockett et al., "Use of a suppression-PCR subtractive hybridization method to identify gene species which demonstrate altered expression in male rat and guinea pig livers following 3-day exposure to [4-chloro-6-(2,3-xylidino)-2-pyrimidinylthio] acetic acid," *Toxicology* 144(1-3):13-29 (2000), attached hereto respectively as Exhibits D and E.

9. These older transcript expression profiling techniques provide analogous expression data, but with far lower throughput.

10. It has been well-established, at least since the introduction of high density spotted microarrays in 1995, that:

(i) each probe on the microarray, with careful design and sufficient length, and with sufficiently stringent hybridization and wash conditions, binds specifically and with minimal cross-hybridization, to the probe's cognate transcript;

(ii) each additional probe makes an additional transcript newly detectable by the microarray, increasing the detection range, and thus versatility, of this analytical device for gene expression profiling;⁴

(iii) it is not necessary that the biological function be known in order for the gene,

⁴ The compelling logic of this proposition has likely motivated the remarkably rapid progress from the earliest high density spotted arrays in 1995 (Schena et al., "Quantitative monitoring of gene expression patterns with a complementary DNA microarray," *Science* 270:467-470 (1995), attached hereto as Exhibit B), to the first whole genome arrays in 1997 (Lashkari et al., "Yeast microarrays for genome wide parallel genetic and gene expression analysis," *Proc. Natl. Acad. Sci. USA* 94(24):13057-62 (1997) and DeRisi et al., "Exploring the metabolic and genetic control of gene expression on a genomic scale," *Science* 278(5338):680-6 (1997), attached hereto as Exhibits F and G, respectively), to the concurrent announcement by two companies earlier this month of their respective commercial introductions of single chip human whole genome arrays (Pollack, "Human Genome Placed on Chip; Biotech Rivals Put it Up for Sale," *The New York Times*, Thursday, October 2, 2003 (Business Day), attached hereto as Exhibit H; "Agilent Technologies ships whole human genome on single microarray to gene expression customers for evaluation," Press Release, Agilent Technologies, October 2, 2003, attached hereto as Exhibit I; "Affymetrix Announces Commercial Launch of Single Array for Human Genome Expression Analysis; More Than 1 Million Probes Analyze Expression Levels of Nearly 50,000 RNA Transcripts and Variants on a Single Array the Size of a Thumbnail," Press Release, Affymetrix, October 2, 2003, attached hereto as Exhibit J).

or a fragment of the gene, to prove useful as a probe on a microarray to be used for expression analysis;

(iv) failure of a probe to detect changes in expression of its cognate gene does not diminish the usefulness of the probe on the microarray; and

(iv) failure of a probe to detect a particular transcript in any single experiment does not deprive the probe of usefulness to the community of users who would use this research tool.

These principles also apply to transcript expression profiling techniques that antedate the development of high density spotted microarrays, and accordingly were well-understood prior to 1995.

11. Moreover, expression profiling is not limited to the measurement of mRNA transcript levels. It is widely understood among molecular and cellular biologists that protein expression levels provide complementary profiles for any given cell and cellular state. Although I cannot claim credit for having coined the phrase, I have written that the difference between transcript expression profiling and protein expression profiling is that "transcriptomics indicates what should happen, and proteomics shows what is happening."⁵

12. For decades, such protein expression profiles have been generated using two dimensional polyacrylamide gel

⁵ Rockett, "Macroresults through Microarrays," *Drug Discovery Today* 7:804 - 805 (2002) (emphasis added), attached hereto as Exhibit K.

electrophoresis (2D-PAGE), and used, among other things, to study drug effects.⁶

13. Although the protein expression profiles produced by 2D-PAGE analysis are analogous to the transcript expression profiles provided by nucleic acid microarrays, an even closer analogy is perhaps offered by antibody microarrays; as I note in my *Drug Discovery Today* commentary, such antibody microarrays date back to the work of Roger Ekins in the mid- to late-1980s.⁷

14. The principles in paragraph 10 also apply to protein expression profiling analyses, particularly to analyses performed using antibody microarrays. Thus, as with nucleic acid microarrays, the greater the number of proteins detectable, the greater the power of the technique; the absence or failure of a protein to change in expression levels does not diminish the usefulness of the method; and prior knowledge of the biological function of the protein is not required. As applied to protein expression profiling, these principles have been well understood since at least as early as the 1980s.

15. Both gene and protein expression profiling are particularly useful to the toxicologist, especially in the pharmaceutical industry. Accordingly, I made the following

⁶ See, e.g., Anderson et al., "A two-dimensional gel database of rat liver proteins useful in gene regulation and drug effects studies," *Electrophoresis* 12:907 - 930 (1991), attached hereto as Exhibit L.

⁷ See Ekins et al., *J. Bioluminescence Chemiluminescence* 5:59-78 (1989); Ekins et al., *Clin. Chem.* 37: 1955-1965 (1991); and Ekins, U.S. Patent Nos. 5,432,099, 5,807,755, and 5,837,551, attached hereto respectively as Exhibits M to Q.

statements in my *Xenobiotica* review, written in the summer of 1998:

[I]n the field of chemical-induced toxicity, it is now becoming increasingly obvious that most adverse reactions to drugs and chemicals are the result of multiple gene regulation, some of which are causal and some of which are casually-related to the toxicological phenomenon *per se*. This observation has led to an upsurge in interest in gene-profiling technologies which differentiate between the control and toxin-treated gene pools in target tissues and is, therefore, of value in rationalizing the molecular mechanisms of xenobiotic-induced toxicity.

Knowledge of toxin-dependent gene regulation in target tissues is not solely an academic pursuit as much interest has been generated in the pharmaceutical industry to harness this technology in the early identification of toxic drug candidates, thereby shortening the developmental process and contributing substantially to the safety assessment of new drugs.

For example, if the gene profile in response to say a testicular toxin that has been well-characterized *in vivo* could be determined in the testis, then this profile would be representative of all new drug candidates which act via this specific molecular mechanism of toxicity, thereby providing a useful and coherent approach to the early detection of such toxicants.

Whereas it would be informative to know the identity and functionality of all genes up/down regulated by such toxicants, this would appear a longer term goal, as the majority of human genes have not yet been sequenced, far less their functionality determined. However, the current use of gene profiling yields a pattern of gene changes for a xenobiotic of unknown toxicity which may be matched to that of well-characterized toxins, thus alerting the toxicologist to possible *in vivo* similarities between the unknown and the standard. . . .

* * *

Despite the development of multiple technological advances which have recently brought the field of gene expression profiling to the forefront of molecular analysis, recognition of the importance of differential gene expression and characterization of differentially expressed genes has existed for many years.

16. As noted in the preceding excerpt from my *Xenobiotica* review, expression profiling in toxicology studies yield patterns of changes that are characteristic of an agent of unknown toxicity, which patterns may usefully be matched to those of well-characterized toxins.

17. In the context of such patterns of gene expression, each additional gene-specific probe provides an additional signal that could not otherwise have been detected, giving a more comprehensive, robust, higher resolution -- and thus more useful -- pattern than otherwise would have been possible.⁸

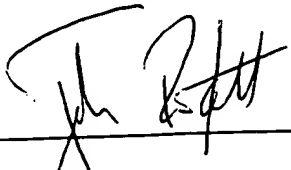
18. It is my opinion, therefore, based on the state of the art in toxicology at least since the mid-1990s -- and as regards protein profiling, even earlier -- that disclosure of the sequence of a new gene or protein, with or without knowledge of its biological function, would have been

⁸ In a sense, each gene-specific probe used in such an analysis is analogous to a different one of the many parts of an engine, with each individual part, or subcombinations of such parts, deriving at least part of their usefulness from the utility of the completed combination, the functioning engine.

sufficient information for a toxicologist to use the gene and/or protein in expression profiling studies in toxicology.

19. The statements made in this declaration represent my individual views and are not intended to represent the opinion of my employer, the United States Environmental Protection Agency, or of any other branch of the federal government. Other than my current engagement to provide this declaration, I have neither had, nor currently have, financial ties to, or financial interest in, Incyte Corporation. I am not myself an inventor on any patent application claiming a gene or gene fragment.

20. I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and may jeopardize the validity of any patent application in which this declaration is filed or any patent that issues thereon.



John Coughlin Rockett III, Ph.D.

10-17-03

Date